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| 10/579,440      | 05/15/2006  | Andrew R. Butz       | 026032-5046         | 7877             |

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| EXAMINER |
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PEDDER, DENNIS H

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| ART UNIT | PAPER NUMBER |
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3612

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09/22/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

|                              |                                      |                                    |  |
|------------------------------|--------------------------------------|------------------------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/579,440 | <b>Applicant(s)</b><br>BUTZ ET AL. |  |
|                              | <b>Examiner</b><br>Dennis H. Pedder  | <b>Art Unit</b><br>3612            |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 7/16/2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-8 and 11-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 11-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1-8, 11-26 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

3. Applicant gives several definitions of “non-structural” in the specification, including “not capable of transferring loads (e.g. from the window regulator system) and “not capable of carrying handling, shipping and non-operational loads created by the weight of regulators, handles, map pockets, wire harnesses, arm rest, and the like”. Applicant further defines “structural” as “when it is attached to a structural component of the vehicle, of carrying any primary crash loads, slam loads, consumer usage loads or window actuation loads...”. It is thus not clear from the first two definitions of “non-structural”, what is intended by this term. For example, the first listed definition could be interpreted to mean that the carrier material is relatively weak, of plastic material for example that would break when the window is activated until such time as it is mounted to the door frame, while the second definition would require a carrier that is bordering on flaccid as even plastic carriers in this art can carry some hardware before assembly. See the attached newly cited reference below.

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4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. Claims 1-8, 11-26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
2. Independent claims are indefinite. Because of the conflicting definitions listed above, the bounds of these claims cannot be determined with specificity to apprise one in this art of potential infringement. The definition of "non-structural" is seen to be subjective and indefinite. How can one determine whether a carrier is structural or non-structural, which latter is an indefinite negative limitation? Applicant, in remarks to the previous office action, repeats the several definitions of "non-structural" from the specification and states that the term is clearly defined by the present application, contrary to the above discussion. Applicant is encouraged to positively recite the invention to eliminate the indefiniteness of the claims, particularly in view of applicant's disclaimers of paragraph [0030] of the specification.

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various

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claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 11, 13, 14 are further rejected under 35 U.S.C. 103(a) as being unpatentable over Kirejczyk (US 6,536,164)(164) in view of Kirejczyk (US 6,862,846)(846).

See column 4, lines 14-22 and column 3, line 49 of .

As to claim 14, conventional manner of column 3, line 61, includes a pin on the trim panel and an aperture on the carrier.

4. Moreover, Kirejczyk discloses that the carrier may be constructed of a plastic material as disclosed for applicant's carrier

5. Kirejczyk (846) teaches, prior to the invention of applicant, that a carrier for a door panel may be **non-structural**, with definition that the hardware components are transported thereon and then the carrier is then mounted to the door inner panel, col. 3, lines 24-44.

6. It would have been obvious to one of ordinary skill to provide in Kirejczyk (164) a non-structural carrier as taught by Kirejczyk (846) in order to reduce weight of the door assembly and hence increase fuel efficiency.

7. Claims 12, 23-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kirejczyk in view of Kirejczyk..

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Kirejczyk discloses the step of removing the trim panel and installing the carrier. Placing the trim panel on a holding fixture during the carrier installation is an obvious expedient to one of ordinary skill in the art.

8. Claims 1-6, 8, 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kirejczyk in view of Kirejczyk and Kameyama.

9. Kameyama teaches a one piece interface member 5 formed with the trim panel. Processes are not given patentable weight in a product claim (MPEP 2113), but plastic articles are commonly molded and the interface member of Kameyama is capable of molding. It would have been obvious to one of ordinary skill to provide in Kirejczyk as modified by Kirejczyk a carrier interface member 3 and door trim interface member 5 as taught by Kameyama has an example of the conventional attachment disclosed by Kirejczyk.

As to claim 3, the juncture of 2 and 3 of Kameyama is U-shaped. Further, U-shaped retainers for hooks are of common knowledge in the art.

As applicant has not challenged this statement of judicial notice, it is made final.

As to claim 6, see remarks above.

As to claim 8, Kirejczyk discloses an armrest support bracket 68. Pull cups are conventionally mounted on armrests, hence member 68 is a conventional pull cup support.

10. Claims 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kirejczyk in view of Kirejczyk and Kameyama as applied to claim 1 above, and further in view of Yazaki Corp, cited by applicant as "Kawamata".

It would have been obvious to one of ordinary skill to provide in the references above impact absorbers as taught by Yazaki Corp. in order to reduce injury.

11. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kirejczyk in view of Kirejczyk as applied to claim 1 above and further in view of Nishikawa et al.

It would have been obvious to one of ordinary skill to provide in Kirejczyk as modified by Kirejczyk in integral impact absorber 16 as taught by Nishikawa et al. in order to reduce injury.

12. Claims 16-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kirejczyk in view of Kirejczyk and Nishikawa et al. as applied to claim 15 above, and further in view of Kameyama.

It would have been obvious to one of ordinary skill to provide in the references above retainers as taught by Kameyama in order to easily attach and remove the trim panel and carrier.

13. Claims 19-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kirejczyk in view of Kirejczyk and Nishikawa et al. as applied to claim 15 above, and further in view of Yazaki Corp.

It would have been obvious to one of ordinary skill to provide in Kirejczyk as modified by Nishikawa et al., with an integral impact absorber, with both upper and lower absorbers as taught by Yazaki Corp. in order to improve protection.

As to claims 20-21, both Nishikawa et al. and Yazaki Corp. detail wall projections.

As to claim 22, see claim 8 above.

***Response to Arguments***

Applicant's arguments filed 7/16/2008 have been fully considered but they are not persuasive. Please see the response above.

***Conclusion***

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Buchta et al. and Rudu et al. are cited for further discussion of "non-structural".

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dennis H. Pedder whose telephone number is (571) 272-6667. The examiner can normally be reached on 5:30-2:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn D. Dayoan can be reached on (571) 272-6659. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Dennis H. Pedder/

Dennis H. Pedder



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Primary Examiner, Art Unit 3612

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DHP  
8/21/2008